

REMARKS

At the time of the First Office Action dated July 30, 2007, claims 1-18 were pending and rejected in this application.

CLAIMS 3, 5, AND 15-16 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C.

§ 112

On pages 2 and 3 of the First Office Action, the Examiner asserted that claims 3, 5, and 15-16 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Regarding claims 3 and 15, the Examiner asserted that "[t]his phrase is grammatically incorrect." Applicant, however, is unclear as to why the Examiner believes the phrases recited in claims 3 and 15 are grammatically incorrect. In this regard, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." However, the Examiner's eventual analysis as to an interpretation of the phrase appears to be correct. Thus, the claim language does have a

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

discernable meaning and, therefore, is not indefinite within the meaning of the second paragraph of 35 U.S.C. § 112.

Regarding claims 5 and 16, Applicant incorporates herein the arguments previously presented with regard to claims 3 and 15. The Examiner's eventual analysis as to an interpretation of the phrase appears to be correct. Thus, the claim language does have a discernable meaning and, therefore, is not indefinite within the meaning of the second paragraph of 35 U.S.C. § 112. Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 3, 5, and 15-16 under the second paragraph 35 U.S.C. § 112.

CLAIMS 1-3 AND 6-8 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BOWMAN-AMUAH, U.S. PATENT NO. 6,662,357, IN VIEW OF FUJIKAWA ET AL., U.S. PATENT NO. 6,735,762 (HEREINAFTER FUJIKAWA), AND FURTHER IN VIEW OF TIM PYRON "SPECIAL EDITION USING MICROSOFT 2000" (HEREINAFTER PYRON)

On pages 3-9 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa and Pyron to arrive at the claimed invention. This rejection is respectfully traversed.

At the outset, Applicant notes that the (2) references found in PAIR do not appear to be the Examiner's cited reference of Pyron. Instead, the references in PAIR are (i) "Applying UML and Patterns: An Introduction to Object-Oriented Analysis and Iterative Development" and (ii) "The Power of Microsoft Project 2000." Thus, Applicant respectfully requests that the Examiner

properly provide the Examiner's cited reference of Pyron in the next action from the Patent Office.

Claim 1

Regarding claim 1, Applicant is unclear as to why the primary reference of Bowman was even cited. Although Bowman refers to object oriented programming, the tasks/job described by Bowman in column 118 appears to be completely unrelated to classes. In this regard, Applicant notes that the claimed invention is to be considered as a whole, and not as individual elements that can be picked from a variety of references without consideration as to how the individual elements contribute to the claimed invention, as a whole. As noted above, the tasks described by Bowman appear completely unrelated to classes, whereas the claimed invention recites that the tasks are generated corresponding to the extracted classes. Moreover, in paragraph 7, the Examiner relied upon Bowman to teach "setting the dependency between the corresponding tasks on the basis of the dependency." As claimed, the dependency, is extracted from the classes, yet whatever dependency described by Bowman is unrelated to classes. By not giving consideration to this interrelationship between the dependency and the classes, the Examiner failed to consider the claimed invention, as a whole.

In paragraph 11, the Examiner asserted the following:

It would have been obvious to a person having ordinary skill in the art at the time of invention to combine the teachings of Bowman and Fukijawa [sic] to extract classes, including dependency information from the design information in order to determine classes that will be influenced by updates to a given class, so that the influenced classes can be thoroughly tested to ensure that they do not malfunction as a result of the update (Fukijawa [sic], col. 1, lines 14-18, also col. 1, lines 43-50).

Applicant disagrees with the Examiner's analysis, the Examiner's citation to column 1, lines 14-18 and 43-50 of Fujikawa does not support the Examiner's obviousness analysis. Specifically,

lines 14-18 merely described that when a program is updated or debugged, the portions affected by the updating or debugging is specified to prevent malfunction. As such, this passage is completely unrelated to classes, extracting dependency from classes, or setting dependencies for corresponding tasks.

The Examiner's second cited passage of lines 43-50 describes that a child class can inherit an attribute/operation (i.e., be dependent upon) a parent class, and that a change to a class requires the child classes to be examined. Although this passages refers to classes and dependency between classes, this passage is silent as to setting dependencies for corresponding tasks based upon dependencies extracted from the classes. Regarding the Examiner's asserted benefit (i.e., so that the influenced classes can be thoroughly tested to ensure that they do not malfunction as a result of the update), although this benefit derives from checking classes, there is no common sense rationale set forth, either by the Examiner or the cited references, that would lead one having ordinary skill in the art to set dependencies for corresponding tasks based upon dependencies extracted from the classes.

In paragraph 12, the Examiner further asserted the following:

Neither Bowman nor Fujikawa disclose generating tasks corresponding to the extracted classes. However, in the combined system (a scheduling used for software development), it is inherent that the tasks generated will correspond to the software being developed, i.e.~ the classes. In the object-oriented system of Fujikawa, the classes are the basic unit of the software under development. It would be obvious to one skilled in the art at the time of invention that in the combined system of Bowman and Fujikawa the tasks generated would correspond to the extracted classes, since the classes need to be implemented in order to develop the software product.

As to the Examiner's assertion that "it is inherent that the tasks generated will correspond to the software being developed," Applicant submits that the Examiner's reliance upon the doctrine of inherency to disclose this feature is misplaced. Inherency may not be established by

probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.² To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.³ Furthermore, reference is made to ex parte Schricker,⁴ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where such a teaching appears in the prior art. Moreover, as already noted above, the jobs/tasks described by Bowman do not appear to be related in any manner to extracted classes forming a system. Therefore, the Examiner has not established that this limitation is inherently disclosed by either Bowman or Fujikawa. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

In paragraph 15, the Examiner further asserted the following:

Neither Bowman nor Fujikawa disclose a third step of scheduling the tasks on the basis of the information on the tasks stored in said given storage device and the information on the dependency between the tasks. However, Pyron discloses that Microsoft project schedules tasks based on information on tasks stored in a storage device, where said information includes dependencies between tasks.

² In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

³ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁴ 56 USPQ2d 1723, 1725 (BPAI 2000).

Again, the Examiner is failing to consider the claimed invention, as a whole, the claimed third step involves the scheduling of tasks (which are generated based upon extracted classes) on the basis of information regarding the tasks and information on the dependency of the tasks (the dependencies of the tasks being set based upon dependencies between the classes). However, the "scheduling of tasks" described by Pyron do not appear to be related to classes or dependencies between classes. Instead, Pyron appears to be a generic teaching of scheduling based upon dependencies.

Claim 6

Claim 6 includes similar limitations to those found in claim 1, and Applicant incorporates herein, as applying to claim 6, the arguments previously presented with regard to claim 1.

Claims 2-3 and 7-8

Although the Examiner relied upon column 118, lines 61-62 of Bowman to teach "if given classes have a relation in which a development of one class requires an earlier development of the other class in said second step, the dependency is set in such a way that a task corresponding to one class concerned is started after termination of a task corresponding to the other class concerned," the passage cited by the Examiner does not disclose these limitations. Instead, the passage cited by the Examiner is a general statement regarding "[t]ask/job sequence enforcement" and is completely silent as to classes. The same arguments apply to claims 3 and 8 since the Examiner relied upon the same cited passage for these claims.

Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1-3 and 6-8 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa and Pyron.

**CLAIMS 4 AND 5 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA AND FURTHER IN VIEW OF LEONARD, U.S. PATENT NO.
5,729,746**

On pages 10-12 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa and Leonard to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 4 includes similar limitations to those found in claim 1, and Applicant incorporates herein, as applying to claim 6, the arguments previously presented with regard to claim 1.

Also, Applicant notes that the Examiner asserted "field of endeavor" of "software engineering" is impermissibly overly broad. If the Examiner's asserted "field of endeavor" was acceptable, then nearly all the patents in the 2100 and 3600 groups (as well as others) could be considered within the same field of endeavor. On this basis, the Examiner could very well dispose of the need to assert a common "field of endeavor" since every single reference ever cited in the 2109 group is probably within the "software engineering" field of endeavor. Not only is Leonard silent as to classes, Leonard is also silent as to object oriented programming. As such, why one having ordinary skill would look to the teachings of Leonard has not been properly established by the Examiner.

Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 4 and 5 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa and Leonard.

CLAIMS 9 AND 10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BOWMAN IN VIEW OF FUJIKAWA, PYRON AND LEONARD

On pages 12-14 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Pyron, and Leonard to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 9 and 10 depend ultimately from independent claim 6, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa and Pyron. The additional reference to Leonard does not cure the argued deficiencies of the prior combination. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Bowman, Fujikawa, and Pyron in view of Leonard, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claims 9 and 10 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Pyron, and Leonard is not viable, and hence, Applicant solicits withdrawal thereof.

**CLAIMS 13-16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA, LEONARD, AND PYRON**

On pages 14-18 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Leonard, and Pyron to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 13 includes similar limitations to those found in claim 4, and Applicant incorporates herein, as applying to claim 13, the arguments previously presented with regard to claim 4. Therefore, Applicant respectfully solicits withdrawal of the imposed rejection of claims 13-16 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Leonard, and Pyron.

**CLAIM 11 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA, PYRON AND NARIMATUS ET AL., U.S. PATENT NO. 5,826,236
(HEREINAFTER NARIMATUS)**

On pages 18 and 19 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Pyron, and Narimatus to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 11 depends ultimately from independent claim 6, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa and Pyron. The additional reference to Narimatus does not cure the argued deficiencies of the prior combination. Accordingly, even if

one having ordinary skill in the art were motivated to modify the combination of Bowman, Fujikawa, and Pyron in view of Narimatus, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claim 11 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Pyron, and Narimatus is not viable, and hence, Applicant solicits withdrawal thereof.

**CLAIM 12 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA, PYRON AND LARMAN**

On pages 19 and 20 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Pyron, and Larman to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 12 depends ultimately from independent claim 6, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa and Pyron. The additional reference to Larman does not cure the argued deficiencies of the prior combination. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Bowman, Fujikawa, and Pyron in view of Larman, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claim 12 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Pyron, and Larman is not viable, and hence, Applicant solicits withdrawal thereof.

**CLAIM 17 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA, LEONARD, PYRON AND NARIMATUS**

On pages 20 and 21 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Leonard, Pyron, and Narimatus to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 17 depends ultimately from independent claim 13, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 13 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Leonard, and Pyron. The additional reference to Narimatus does not cure the argued deficiencies of the prior combination. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Bowman, Fujikawa, Leonard, and Pyron in view of Narimatus, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claim 17 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Leonard, Pyron, and Narimatus is not viable, and hence, Applicant solicits withdrawal thereof.

**CLAIM 12 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BOWMAN IN VIEW OF FUJIKAWA, LEONARD, PYRON AND LARMAN**

On pages 21 and 22 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Bowman in view of Fujikawa, Leonard, Pyron, and Larman to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 12 depends ultimately from independent claim 13, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 13 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Leonard, and Pyron. The additional reference to Larman does not cure the argued deficiencies of the prior combination. Accordingly, even if one having ordinary skill in the art were motivated to modify the combination of Bowman, Fujikawa, Leonard, and Pyron in view of Larman, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claim 18 under 35 U.S.C. § 103 for obviousness based upon Bowman in view of Fujikawa, Leonard, Pyron, and Larman is not viable, and hence, Applicant solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: October 30, 2007

Respectfully submitted,

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